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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Baer	STL000017US1	5170

23373 7590 09/15/2005

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EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/488,969

**Applicant(s)**

BAER ET AL.

**Examiner**

Maikhanh Nguyen

**Art Unit**

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

1. This action is responsive to communications: Appeal Brief filed 06/28/2005 to the original application filed 01/21/2000.
2. Claims 1-15 are currently pending in this application. Claims 1, 6 and 11 are independent claims.
3. In view of the Appeal Brief filed on 06/28/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection s set forth below.  
  
To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
  - (b) request reinstatement of the appeal.
4. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention, appearing to be comprised of software alone without claiming associated computer hardware required for execution, is not supported by either a specific and substantial asserted utility (i.e., transformation of data) or a well established utility (i.e., a practical application). The claimed steps do not define a machine or computer implemented process (see MPEP 2106).

***Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated **Tabuch** (U.S. 6,606,633 – filed 09/1999).

**As to independent claim 1:**

Tabuch teaches a method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities (*structure rules defining a possible structure of relations of objects are accumulated and a rule searching means for checking a*

*possibility/impossibility of relating of a data object with reference to the structure rule table; see the Abstract and col.5, lines 12-57), comprising the steps of:*

*upon addition or removal of a content entity to or from the compilation,  
determining if the content entity has any prerequisite content entities, and if so,  
adding (adding) or removing (deleting) the prerequisite content entities (see the  
rule adding and deleting discussion beginning at col.10, line 59).*

**As to dependent claim 2:**

*Tabuch teaches one or more of the prerequisites are conditional (the rule searching means 122 sees, when a data object is ...or when to a; col.8, lines 57-62).*

**As to dependent claim 3:**

*Tabuch teaches the conditions for applying a prerequisite are defined in one or more rules (rules; see the Abstract).*

**As to dependent claim 4:**

*Tabuch teaches in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules (see fig.5 and the deleting a structuring rule from the structuring rule table, beginning at col.11, line 11).*

**As to dependent claim 5:**

*Tabuch teaches the step of rewriting any negative rules as positive rules (whether a structuring rule is being used in a compound document object or can not be recognized ... when the number of references of the designated structuring rule is not 0, the structuring rule in question will not be deleted; col.11, lines 23-37).*

**As to independent claim 6:**

It is directed to a program storage device for implementing the method of claim 1, and is similarly rejected under the same rationale.

**As to independent claim 11:**

It is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

**As to dependent claims 7-10:**

They include the same limitations as in claims 2-5, and are similarly rejected under the same rationale.

**As to dependent claims 12-15:**

They include the same limitations as in claims 2-5, and are similarly rejected under the same rationale.

***Response to Arguments***

7. Applicant's arguments filed 06/28/2003 have been fully considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

*William F. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
9/13/2005